

This Opinion is Not a  
Precedent of the TTAB

Mailed: May 5, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re GFactor Enterprises, LLC d/b/a Gfactor Films*

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Serial No. 90976324  
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Andrea H. Evans of The Law Firm of Andrea Hence Evans, LLC,  
for GFactor Enterprises, LLC d/b/a Gfactor Films.

Theodore Sotland, Trademark Examining Attorney, Law Office 105,  
Katrina Goodwin, Managing Attorney.

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Before Lykos, Heasley and Hudis,  
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

GFactor Enterprises, LLC d/b/a Gfactor Films (“Applicant”) sought registration on the Principal Register of the proposed standard character mark MAKE YOUR PASSION YOUR PAYCHECK for:

**in Application Serial No. 90159334 (the “334 Application”)**

Series of non-fiction books in the field of passion, self-awareness, EQ-emotional intelligence, student, adolescent, adult and career success in International Class 16, and

Education services, namely, providing classes, seminars, and workshops in the fields of passion, self-awareness, EQ-emotional intelligence, student, adolescent, adult and career success; Educational and entertainment services, namely, providing motivational speaking

services in the field of passion, self-awareness, EQ-Emotional Intelligence, student and career success in International Class 41.<sup>1</sup>

as well as for:

**in Application Serial No. 90976324 (the “324 Application”)**

Hats; T-shirts; Hoodies; Knit face masks being headwear in International Class 25.<sup>2</sup>

On February 2, 2022, the Board issued a final decision affirming the Examining Attorney’s refusal to register, under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), Applicant’s MAKE YOUR PASSION YOUR PAYCHECK mark of the ’334 Application for the goods and services in Classes 16 and 41. The present appeal concerns the Examining Attorney’s refusal to register Applicant’s MAKE YOUR PASSION YOUR PAYCHECK mark of the ’324 Application on a different ground.

**I. Prosecution History of the Applications**

On September 4, 2020, Applicant filed the ’334 Application reciting the goods and services identified above in Classes 16, 25 and 41. In a first Office Action issued on January 19, 2021, the Trademark Examining Attorney refused registration under Trademark Act Section 2(d), on the ground that Applicant’s mark, as applied solely to the goods and services identified in Classes 16 and 41 of the ’334 Application, so resembled the mark MAKE YOUR PASSION YOUR PROFESSION, registered on

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<sup>1</sup> Application Serial No. 90159334 was filed on September 4, 2020, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), for the goods in Class 16, based on Applicant’s allegation of a bona fide intention to use the mark in commerce; and under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), for the services in Class 41, based on Applicant’s claim of first use of the mark anywhere and first use in commerce since at least as early as October 12, 2018.

<sup>2</sup> Application Serial No. 90976324, the child application arising from Application Serial No. 90159334, has an effective filing date of September 4, 2020, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a) for the goods in Class 25, based on Applicant’s claim of first use of the mark anywhere and first use in commerce since at least as early as July 28, 2018.

the Principal Register for “[e]ducational services, namely, providing courses of instruction at the undergraduate and professional level” in International Class 41,<sup>3</sup> as to be likely to cause confusion, mistake, or deception. On October 16, 2020, Applicant submitted its response, providing evidence and argument traversing the Trademark Act Section 2(d) refusal.

In a second Office Action issued on July 28, 2021, the Examining Attorney refused registration under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127, on the ground that Applicant’s proposed mark, as applied to all of the goods and services identified in Classes 16, 25 and 41 of the ’334 Application, is a commonplace term, message, or expression, widely used by a variety of sources, that merely conveys an ordinary, familiar, well-recognized concept or sentiment. As such, the proposed mark is a slogan or term that does not function as a trademark or service mark to identify and distinguish Applicant’s goods or services from the goods or services of others and to indicate the source of those goods and services. The Examining Attorney also continued and maintained the likelihood of confusion refusal under Trademark Act Section 2(d) as to the goods and services identified in Classes 16 and 41 of the ’334 Application. On August 25, 2021, Applicant submitted its response, providing evidence and argument traversing the Trademark Act Sections 1, 2, 3, and 45 refusal and the Trademark Act Section 2(d) refusal.

In a third and final Office Action issued on November 12, 2021, the Examining Attorney continued, maintained and made final the failure-to-function refusal under

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<sup>3</sup> Registration No. 3211181 was issued on February 20, 2007; renewed.

Trademark Act Sections 1, 2, 3, and 45 as to all goods and services, as well as the Trademark Act Section 2(d) refusal as to the goods and services in Classes 16 and 41.

On November 22, 2021, Applicant filed a request to divide the '334 Application. On January 24, 2022, the Divisional Unit of the U.S. Patent and Trademark Office ("USPTO") processed Applicant's request to divide. Pursuant to Applicant's request, the USPTO maintained the goods and services of Classes 16 and 41 in the original ("parent") '334 Application. The goods of Class 25 are now identified in the newly-created ("child") '324 Application.

On May 12, 2022, after the Examining Attorney made the refusals final and the Divisional Unit processed Applicant's request to divide, Applicant filed separate appeals to this Board. Applicant and the Examining Attorney filed briefs in each appeal. As noted, on February 2, 2022, the Board issued a final decision affirming the Examining Attorney's refusal to register Applicant's MAKE YOUR PASSION YOUR PAYCHECK mark of the '334 Application for the goods and services in Classes 16 and 41 under Trademark Act Section 2(d), on the ground of a likelihood of confusion with the registered MAKE YOUR PASSION YOUR PROFESSION mark and above-noted services in Class 41.

The Examining Attorney did not issue the Trademark Act Section 2(d) refusal with respect to Applicant's MAKE YOUR PASSION YOUR PAYCHECK mark of the '324 Application for the goods in Class 25, maintaining only the failure-to-function refusal under Trademark Act Sections 1, 2 and 45. On February 3, 2023, we suspended proceedings in this appeal and remanded the '324 Application to the

Examining Attorney to consider a possible new ground for refusal under Trademark Act Section 2(d) in view of our decision regarding the appeal as to the '334 Application.

On April 25, 2023, the Examining Attorney issued an Office Action “declin[ing] to issue the [Trademark Act Section] 2(d) refusal and ... mov[ing] forward with the failure to function refusal.” On April 27, 2023, the Board resumed proceedings. We reverse the refusal to register Applicant’s mark under Trademark Act Sections 1, 2 and 45 as to the goods in Class 25.<sup>4</sup>

## **II. Applicable Law: Failure to Function – Widely Used Commonplace Expression**

Sections 1, 2 and 45 of the Trademark Act provide the statutory basis for refusal to register subject matter that does not function as a trademark or service mark. 15 U.S.C. §§ 1051, 1052 and 1127. Specifically:

- Sections 1 and 2 provide for an application and the registration on the Principal Register of “trademark[s] by which the goods of the applicant may be distinguished from the goods of others”;
- Section 45 defines a “trademark” in pertinent part, as “any word, name, symbol, or device, or any combination thereof ... used by a person, or ... which a person has a bona fide intention to use in commerce ... to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others, and to indicate the source of the goods, even if that source is unknown.”

The USPTO thus “is statutorily constrained to register matter on the Principal Register if and only if it functions as a mark.” *In re Brunetti*, 2022 USPQ2d 764, at

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<sup>4</sup> Page references herein to the application record refer to the online database of the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board’s TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

\*9 (TTAB 2022). *See also In re Vox Populi Registry, Ltd.*, 25 F.4th 1348, 2022 USPQ2d 115, at \*2 (Fed. Cir. 2022) (“Under the Lanham Act, ‘[n]o [trademark] by which the [goods] of the applicant may be distinguished from the [goods] of others shall be refused registration on the principal register on account of its nature’ subject to certain exceptions. 15 U.S.C. §[ 1052]. One of these exceptions is that a [trademark] must function to ‘identify and distinguish the [goods] of one person ... from the [goods] of others and to indicate the source of the [goods].’ 15 U.S.C. § 1127.”); *see also, e.g., In re The Ride*, 2020 USPQ2d 39644, at \*5-6 (TTAB 2020).

“Matter that does not operate to indicate the source or origin of the identified goods ... and distinguish them from those of others does not meet the statutory definition of a trademark and may not be registered ....” *In re Greenwood*, 2020 USPQ2d 11439, at \*2 (TTAB 2020) (quoting *In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at \*2-3 (TTAB 2020)). Not every designation adopted with the intention that it perform a trademark function necessarily accomplishes that purpose. *In re Texas With Love, LLC*, 2020 USPQ2d 11290, at \*2-3 (TTAB 2020) (quoting *In re Pro-Line Corp.*, 28USPQ2d 1141, 1142 (TTAB 1993) (“Mere intent that a phrase function as a trademark is not enough in and of itself to make it a trademark.”)).

“Matter may ... fail to function as a trademark if it is a common term or phrase that consumers of the goods ... identified in the application are accustomed to seeing used by various sources to convey ordinary, familiar, or generally understood concepts or sentiments.” *In re Brunetti*, 2022 USPQ2d 764, at \*12. Such widely used

messages will be understood as merely conveying the ordinary concept or sentiment normally associated with them, rather than serving any source-indicating function. *See, e.g., D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (granting petition to cancel registration of the mark I ♥ DC for clothing on the Supplemental Register, and sustaining opposition to registration of the mark for additional clothing items, where “the marketplace ... [was] awash in products that display the term”, “ha[d] been widely used, over a long period of time and by a large number of merchandisers as an expression of enthusiasm, affection or affiliation with respect to the city of Washington, D.C.[.]” and thus would not be perceived as a source-indicator).

“Consumers ordinarily take widely-used, commonplace messages at their ordinary meaning, and not as source indicators, absent evidence to the contrary.” *In re Greenwood*, 2020 USPQ2d 11439, at \*6 (citing *In re Mayweather Promotions, LLC*, 2020 USPQ2d 11489, at \*6 (TTAB 2020). “The more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark.” *Id.* (citing *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010)). “Where the evidence suggests that the ordinary consumer would take the words at their ordinary meaning rather than read into them some special meaning distinguishing the goods and services from similar goods and services of others, then the words fail to function as a mark.” *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at \*3 (TTAB 2019) (internal punctuation omitted).

On the other hand, where the evidence is insufficient to show that the proposed mark has been widely used by third parties in connection with the goods at issue, refusing registration on the ground that it fails to function as a mark is improper. *In re Lizzo LLC*, 2023 USPQ2d 139, at \*39 (TTAB 2023) (“[T]he totality of the evidence of record ... undercuts a finding that 100% THAT BITCH is a commonplace expression, so widely used by third parties that consumers would not perceive it as indicating the source of the goods identified thereby.”); *Cf. City of London Distillery, Ltd. v. Hayman Grp. Ltd.*, 2020 USPQ2d 11487, at \*12 (TTAB 2020) (“[W]e do not view the record here as showing that the phrase [CITY OF LONDON] is so ... commonly used in connection with gin that it is incapable of being perceived, in the eyes of the gin-consuming public, as a source identifier ... in derogation of Sections 1, 2 and 45 of the Trademark Act.” (emphasis original)).

Thus, “[t]he critical inquiry in determining whether a proposed mark functions as a trademark is how the relevant public perceives the term sought to be registered.” *Univ. of Ky. v. 40-0, LLC*, 2021 USPQ2d 253, at \*25 (TTAB 2021) (citing *In re Greenwood*, 2020 USPQ2d 11439, at \*2). When “there are no limitations on the channels of trade or classes of consumers of the [goods] identified in the application, the relevant consuming public comprises all potential purchasers of ... [such goods].” *Id.* at \*25 (citing *In re Mayweather Promotions*, 2020 USPQ2d 11489, at \*3). “To make this determination, we look to [any] ... evidence of record showing how the designation is actually used in the marketplace.” *In re Texas with Love*, 2020 USPQ2d 11290, at \*2 (quoting *In re Eagle Crest*, 96 USPQ2d at 1229), and noting

that “widespread use of a term or phrase may be enough to render it incapable of functioning as a trademark, regardless of the type of message.”).

### III. The Examining Attorney’s Arguments and Evidence

The Examining Attorney argues:

The ... mark “MAKE YOUR PASSION YOUR PAYCHECK” in standard characters does not function as a trademark or service mark to indicate the source of applicant’s goods or services because the evidence of record establishes that this phrase is an expression commonly used by multiple sources. Particularly, this phrase is commonly used by third parties to express the common motivational message or sentiment that one should do what they love for work.<sup>5</sup>

In support, the Examining Attorney made the following evidence of record:<sup>6</sup>

1)



**Website text:** It is possible to make money doing almost anything. ... Many of you right now have a unique talent or activity that you are passionate about. It is something you do often, and have been complimented on by others who have seen this skillset in you even if you haven’t been able to see it in yourself. You may have an idea to improve a service, or act as a broker to connect supply and demand where you have noticed a void. Noticing any void or poor process is a direct invitation to an opportunity for improvement, and if you can fill the void making money will be sure to follow. (chrismcpherson.net) [Office Action of July 28, 2021, at TSDR 6].

**Comment and Analysis:** Example 1 shows service mark use of “MAKE YOUR PASSION YOUR PAYCHECK” in connection with advisory services for

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<sup>5</sup> Examining Attorney’s Brief, 6 TTABVUE 5.

<sup>6</sup> Between the Office Actions of July 28, 2021 and November 12, 2021 issued during prosecution, the Examining Attorney made of record duplicative third-party website evidence. “Suffice it to say, the probative value of documentary evidence does not increase with repetition, it needlessly increases the size of the record, and makes review of the record more difficult.” *In re Six Continents Ltd.*, 2022 USPQ2d 135, at \*3 (TTAB 2022).

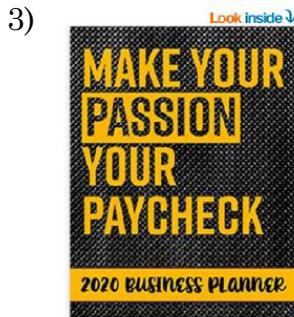
teaching others how to make money from one's unique talent, activity or skillset.

- 2) But first, a word from Jamie on the sacred work of Making Your Passion Your Paycheck!



**Website text:** Wanderlust Speakeasy: Please enjoy this video series of Jamie interviewing the esteemed Dr. Deepak Chopra on the secrets to his success and ours. But first, a word from Jamie on the sacred work of MAKING YOUR PASSION YOUR PAYCHECK! (jamiezmd.com) [Office Action of July 28, 2021, at TSDR 7].

**Comment and Analysis:** Example 2 shows use of “MAKING YOUR PASSION YOUR PAYCHECK!” in connection with still-shot of a video presentation of undefined content (because it was not provided).



**Website text:** Business Planner: 2020 Business productivity planner specially designed for women entrepreneurs and business ... for businesswomen. (amazon.com) [Office Action of July 28, 2021, at TSDR 8].

**Comment and Analysis:** Example 3 shows use of the expression MAKE YOUR PASSION YOUR PAYCHECK on the front cover of a business planner.

4)



**Website text:** Girls Ideas Journal – Blank Lined Notebook For Women To Write Business Ideas, Plans, Thoughts, Income Streams Ideas. (amazon.com) [Office Action of July 28, 2021, at TSDR 9].

**Comment and Analysis:** Example 4 shows use of the expression MAKE YOUR PASSION YOUR PAYCHECK on the front cover of a blank lined notebook.

5)

*Note To Self: 5 Ways To Make Your Passion Your Paycheck*



**Website text:** “Do what you love and you never work a day in your life” is probably one of the best career-related quotes. It is a dream for many, a reality for few, to make money by doing the things that you love and are good at. In the CGD office, we believe that everything is possible as long as you are willing to get off your butt, go out and get it. So here is to everyone that would like to make a living doing what you love! We give you 5 ways to make that .... (cut off) (careergirldaily.com) [Office Action of July 28, 2021, at TSDR 10].

**Comment and Analysis:** Example 5 shows use of the expression MAKE YOUR PASSION YOUR PAYCHECK to refer to a book chapter titled “Money Looks Better in the Bank Than on Your Feet.” It appears to be part of an overall discussion of career advice.

6)



**Website text:** Self-Study Resources: I have tons of self-study bundles and resources you can dive into on mindset, manifestation, business, journaling, and so much more. I designed these as tools for you to self-coach yourself through your own transformation; Breakthrough Session: We'll pinpoint the biggest mindset block you're currently struggling with and do the transformational work to reprogram it. 3-Month Coaching Series: If you're ready to revolutionize your mindset and step into a new level of success and abundance in your business, this high-level 3-month coaching program is for you. (jessicaestrada.net) [Office Action of July 28, 2021, at TSDR 11-12].

**Comment and Analysis:** Example 6 shows trademark and service mark use of "HOW TO MAKE YOUR PASSION YOUR PAYCHECK" in connection with self-study materials and coaching services for career advancement.

7)



**Website text:** When I was young I was taught to go to school, college and university because that will end up with a good job and great pay. And that is just what I did. Coaching services and careers blog. (hayleyaustincoaching.com) [Office Action of July 28, 2021, at TSDR 13-14].

**Comment and Analysis:** Example 7 shows service mark use of "HOW TO MAKE YOUR PASSION YOUR PAYCHECK" in connection with coaching services and an informational blog. Insufficient content from this website was provided to discern further the nature of these services.

8) Making your passion your paycheck

June 26, 2018

Imagine waking up every morning, excited to jump out of bed and greet the day ahead. A day full of everything you want to do. Reading your favorite blogs, writing, catching up on the latest Hollywood news, grabbing a mid-morning tea with a girlfriend before heading to yoga.

Then getting your BOSS on with meetings and socialite events. Maybe there's even a photoshoot thrown in the mix before you head home to wrap up emails and plan for the following day.

Whatever your passion is, there is a way to make it a part of your life. In fact, it is a necessity. Whether you're doing it just for fun, or want to get paid, giving yourself permission to follow your passion is an important step in feeling fulfilled.

We, of course, are big fans of you getting paid to pursue your passion. Because money is a tool for you to be able to further express your creative talents and experience all that life has to offer. If you haven't already, be sure to read our 14 reasons why you need to launch your side hustle. NOW. Once you're done reading it, let's get to work and make your passion your paycheck.

Here are the ten steps to take to make your dream life, a reality:



Hi, I'm Danetha.

I started Money & Mimosas to be a financial education resource for self-employed folks.

**Website text:** Whatever your passion is, there is a way to make it a part of your life. In fact it is a necessity. Whether you're doing it just for fun, or want to get paid, giving yourself permission to follow your passion is an important step in feeling fulfilled. ... We, of course, are big fans of you getting paid to pursue your passion. Because money is a tool for you to be able to further express your creative talents and experience all that life has to offer. If you haven't already, be sure to read our 14 reasons why you need to launch your side hustle. NOW. (moneyandmimosas.com) [Office Action of November 12, 2021, at TSDR 14].

**Comment and Analysis:** Example 8 shows use of MAKING YOUR PASSION YOUR PAYCHECK as the title of an informational blog entry providing advice on getting paid by engaging in an activity for which one is passionate.

9)



**Website reference:** t-shirt (breascustomcreations.com) [Office Action of November 12, 2021, at TSDR 15].

**Comment and Analysis:** Example 9 is simply the expression MAKE YOUR PASSION YOUR PAYCHECK emblazoned on a t-shirt.

## 10) Make Your Passion Your Paycheck

August 12, 2016

I am a strong believer in "loving what you do". I know first hand what it's like to work somewhere only to get a paycheck. I understand that sometimes responsibilities may come up and you may need that job to keep a float, but it's all about time management. Find a balance between the time you spend at work and use any extra time you have to think of a master escape plan! I remember looking at the Instagram pages of my cohorts who had started a successful business and thinking "If only I had started on my plan I could have been there by now" until one day I looked around and decided a change had to come and soon. I quit my retail job and started working toward bigger and better things, including Novateur Brand Architecture. Don't get me wrong, things didn't happen over night and there were times that I thought I had made a big mistake by quitting on a whim like that but I also knew that God had never steered me wrong before and knew he wouldn't start now.

**Website text:** I am a strong believer in “loving what you do”. I know first-hand what it's like to work somewhere only to get a paycheck. I understand that sometimes responsibilities may come up and you may need that job to keep afloat. but it's all about time management. Find a balance between the time you spend at work and use any extra time you have to think of a master escape plan! ... I now get to hear the dreams and schemes of others and help them mold that dream into something real and I love every second. If you have dreams and aspirations, go for them and put your all into it. I promise the outcome will be soooo worth it. Don't Just sit around and hope for a better day, start planning and building for that day TODAY! Need more help making your dream a reality? let's Chat! (nbabranding.com) [Office Action of November 12, 2021, at TSDR 16].

**Comment and Analysis:** Example 10 shows use of MAKE YOUR PASSION YOUR PAYCHECK as the title of an informational blog entry providing advice on molding one's dream aspirations into a money-making pursuit.

## 11) Make Your Passion Your Paycheck

If you are getting into the business with the sole intention being money, then maybe you need to have a rethink

By Nishchay Gogia February 15, 2018

*Opinions expressed by Entrepreneur contributors are their own.*

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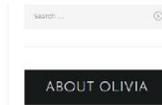
Light yourself on fire with passion and people will come from miles to watch you burn, these words by John Wesley should be etched in the minds of every entrepreneur who is ready to follow his / her dream and turn it into a business. To be able to turn your passion into your business is something that everyone wishes for. Here is a quick checklist of things that you should be willing to do once you take the plunge.

**Website text:** If you are getting into the business with the sole intention being money, then maybe you need to have a rethink. Light yourself on fire with passion and people will come from miles to watch you burn, these words by John Wesley should be etched in the minds of every entrepreneur who is ready to follow his/her dream and turn it into a business. To be able to turn your passion into your business is something that everyone wishes for. Here is a quick checklist of things that you should be willing to do once you take the plunge. (entrepreneur.com) [Office Action of November 12, 2021, at TSDR 18].

**Comment and Analysis:** Example 11 is the title of an article providing advice to entrepreneurs for following one's dream and turning it into a business.



INVENT YOUR DREAM JOB -  
MAKE YOUR PASSION YOUR  
PAYCHECK



**Website text:** Olivia Omega is a branding strategist, speaker and author of Beautifully Balanced: The Girl’s Guide to Personal Branding. (laughlivlove.com) [Office Action of November 12, 2021, at TSDR 19].

**Comment and Analysis:** Example 12 appears to be the title of an article authored by a personal branding consultant, but insufficient content was captured discern its content.



**Website text:** There are a million articles on finding your passion but once you’ve identified what it is you want to do with your life, how do you make your passion your paycheck? These strategies outlined below will help you to do what you love and make money turning your passion to profit. (thebeauticle.com) [Office Action of November 12, 2021, at TSDR 20].

**Comment and Analysis:** Example 13 is the title of an article providing strategies for doing what one loves and making money turning one’s passion to profit.



**Website reference:** Wall art, in wood frame ready to hang (sensefordecor.com) [Office Action of November 12, 2021, at TSDR 21].

**Comment and Analysis:** Example 14 is simply the expression MAKE YOUR PASSION YOUR PAYCHECK emblazoned on wall art.

#### IV. Applicant's Arguments

Applicant argues that “[t]he wording MAKE YOUR PASSION YOUR PAYCHECK feels like a slogan mark, as it assigns an incongruous meaning of turning a ‘passion’ into a ‘paycheck,’ a concept that does not inform anyone of anything[.]”<sup>7</sup> relying principally on *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455 (TTAB 1998). We find *In re Volvo* inapt, because the appeal in that proceeding involved the proposed mark DRIVE SAFELY (for “automobiles and structural parts therefor”), which was found to have conveyed a familiar safety admonition expressing a concern about the safe operation of motor vehicles. *Id.* at 1461. Thus, *In re Volvo* involved a failure-to-function refusal based on the notion that the proposed mark was merely informational to consumers. Here, the failure-to-function refusal is grounded on the concept that MAKE YOUR PASSION YOUR PAYCHECK is an expression so widely used by others that it is incapable of designating a single source of Applicant’s goods.

Applicant also argues that its “specimens [of use] are of great significance in determining whether its slogan is capable of functioning as a trademark, ... [as] the large text size and proper use as an apparel specimen indicate that the wording is intended to be perceived as a source indicator[.]”<sup>8</sup> citing *In re Post Properties, Inc.*,

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<sup>7</sup> Applicant’s Brief, 4 TTABVUE 8.

<sup>8</sup> Applicant’s Brief, 4 TTABVUE 9.

227 USPQ 334 (TTAB 1985). We find *In re Post Properties* inapplicable, because the appeal in that proceeding involved whether QUALITY SHOWS was used as a service mark to identify and distinguish the applicant's real estate management and leasing services. The Board found that the mark was set apart from the text of the advertisements shown in the submitted specimens of use in such a way that prospective customers would recognize it as a slogan identifying and distinguishing the applicant's services. *Id.* at 335. Thus, *In re Post Properties* involved a failure-to-function refusal based on the way the applicant's mark was displayed on its specimen. That is not the nature of the failure-to-function refusal raised by the Examining Attorney in this appeal.

Attacking the third-party website examples the Examining Attorney made of record, Applicant states that "they are simple website submissions that are [not] determinative of how the [MAKE YOUR PASSION YOUR PAYCHECK] mark is used with Applicant's own products[.]" "do not offer any comparison of how the mark is perceived by the general public" and "do not support the concept of [the] wording being widely understood[.]"<sup>9</sup> In sum, Applicant argues that "[t]he Examining Attorney's evidence is not enough to support the high standard needed to prove nationwide interest or a phrase that is spoken daily without much thought."<sup>10</sup> Rather, says Applicant, "the wording [MAKE YOUR PASSION YOUR PAYCHECK] is likely never spoken by anyone in common parlance, but it is a clever slogan that suggests

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<sup>9</sup> Applicant's Brief, 4 TTABVUE 11-12.

<sup>10</sup> Applicant's Brief, 4 TTABVUE 12.

that someone’s strong and barely controllable emotions can lead to them earning money.”<sup>11</sup>

## V. Discussion and Analysis

We find the evidence made of record by the Examining Attorney is insufficient to establish that the MAKE YOUR PASSION YOUR PAYCHECK is so widely used by a variety of sources that it merely conveys an ordinary, familiar, well-recognized concept or sentiment.

During prosecution, the Examining Attorney provided a limited number of third-party uses (14 in all) of MAKE YOUR PASSION YOUR PAYCHECK, and its variants, by motivational speakers, professional coaches, career planners, and in articles and other printed materials in a variety of different contexts. As we note above, some third-party uses are service mark uses. Others are titles of books, or emblazoned in an ornamental manner on t-shirts or artwork.<sup>12</sup> As a whole, the record does not uniformly demonstrate commonplace third-party use of MAKE YOUR PASSION YOUR PAYCHECK, and its variants, in relation to the common topic of self-help and motivation to convey the well understood message that one should do what they love, and make money doing so – as argued by the Examining Attorney.

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<sup>11</sup> Applicant’s Brief, 4 TTABVUE 14.

<sup>12</sup> See, e.g., *In re Team Jesus LLC*, 2020 USPQ2d 11489, at \*5 (TTAB 2020) (“Most of the third-party clothing evidence shows use of TEAM JESUS in an ornamental manner, such as the t-shirts shown above with the words emblazoned in large letters across the front, presumably offered for consumers who want to convey their Christian affiliation by wearing apparel that prominently proclaims that message.”). Notably, the evidentiary record in *In re Team Jesus* was far more extensive in supporting the failure-to-function refusal than we have before us in the present appeal.

Due to the mixed record presented by the Examining Attorney, we cannot say that, in view of the wide usage of the phrase, consumers of Applicant's goods are consistently accustomed to seeing this phrase used by various sources to convey ordinary, familiar, or generally understood concepts or sentiments such that they could not attribute the phrase to a single source. *Cf. In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987) ("The mixture of usages unearthed by the ... [Examining Attorney] does not show ... that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which Merrill Lynch first applied the term.").

Consequently, the Examining Attorney's refusal to register MAKE YOUR PASSION YOUR PAYCHECK mark for the goods identified in Class 25, on the ground that it is a phrase widely used by third parties and thus incapable of indicating the source of Applicant's goods, must be reversed.

**Decision:**

The refusal to register Applicant's mark MAKE YOUR PASSION YOUR PAYCHECK for the identified goods in Class 25 is reversed.